

### **REMARKS**

Claims 10 and 12 have been canceled. Claims 1-9, and 11 are pending in the application. Applicants amend claims 9 and 11 for further clarification. No new matter has been added..

Claims 9 and 11 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Applicants amend claims 9 and 11 in accordance with the Examiner's recommendation, and respectfully request that the Examiner withdraw the § 101 rejection.

Claims 9 and 11 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.

The Examiner rejected these claims by contending that a program and structure are incongruous. Applicants respectfully submit that programs can include particular structure, especially in view of object-oriented programming wherein "objects" define the structure and corresponding functionality of a program. The specification includes clear description of such structure in terms of both hardware and software. Accordingly, Applicants respectfully request that the Examiner withdraw the § 112, ¶ 2 rejection.

Claims 1, 6, and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,634,012 to Stefik et al.; and claims 2-5, 7-8, and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Stefik et al. in view of U.S. Patent No. 5,872,588 to Aras et al. Applicants respectfully traverse the rejections.

The Examiner maintained that the description in Stefik et al. of "metering usage rights attached to a digital work [causing] the metering and clock functions to occur in the credit server" discloses the claimed feature of digital information itself, which is embedded in

content, providing functionality to a user terminal to, say, monitor and store utilizing history.

Page 3, line 14 et seq. of the Office Action. (Emphasis added)

Applicants respectfully submit that simple causation fails to disclose or even suggest the claimed feature of “providing functionality.” Indeed, Stefik et al., as cited and relied upon by the Examiner, teach away from such a feature.

The technique described in the cited portions of Stefik et al. is specifically rooted in usage rights being permanently attached to digital works, and “enforcement elements” being “embodied in repositories.” Please see, e.g., col. 6, lines 50-60 of Stefik et al. Such repositories, which are beyond a digital work user’s access, “control access to the digital works, bill for access to digital works and maintain the security and integrity of the system.” Col. 6, lines 58-60 of Stefik et al. (Emphasis added) Thus, the “metering and clock functions” taken from Stefik et al. by the Examiner rely upon secure entities, such as repositories, to include secure functionality for performing such “enforcement” functions. And the usage rights, at most, include parameters “[defining] how the digital work may be used or further distributed” as enforced by the secure functionality provided by the “enforcement elements.” Abstract and col. 6, lines 50-60 of Stefik et al.

As illustrated in Fig. 15 of Stefik et al., the usage rights only include a number of parameters and references that rely upon predefined secure functions performed by the “enforcement elements,” as illustrated in Figs. 16-18 of Stefik et al., to make use of such parameters accordingly. In other words, the usage rights, in isolation, do not themselves provide any functionality, but they merely call functions already defined in the entities that refer to those usage rights for performing functions according to parameters defined in the usage rights. And, thus, as Applicants have previously pointed out, the usage rights described in the cited portions of Stefik et al. merely define usage rights of the digital works they are attached to, and do not themselves provide functionality to a user terminal to monitor and

store usage history at the user terminal. Indeed, the portions of Stefik et al. cited against the claimed digital information embedding features—col. 8, lines 4-9, 10-20, 57-67; col. 9, lines 1-5; col. 10, lines 24-34, 45-67; col. 11, lines 1-13; col. 17, lines 48-67; col. 18, lines 1-45; and Fig. 3—only include description of usage rights and “digital work state information” that are restricted to repositories and that merely reflect a state of a corresponding work.

In other words, Stefik et al., as cited and relied upon by the Examiner, fail to disclose,

“[a] method for managing fees of contents in which the fees arise based on a predetermined charging rule upon distributing the contents, said method comprising the steps of:

equipping information gathering means on a network with which a user terminal is allowed to connect, said user terminal carrying out information processing by utilizing said contents;

embedding digital information to said contents, said digital information *itself providing functionality to said user terminal* to autonomously monitor, and store, a contents utilizing history at the user terminal, and transmit the stored contents utilizing history along with identification information to said information gathering means at a predetermined timing while said user terminal is connected with said network;

distributing said contents with said digital information being embedded through a predetermined distribution mechanism;

holding, by predetermined identification information holding means, identification information for identifying said distributed contents and said distribution mechanism;

counting a distribution condition of contents per distribution mechanism based on said contents distributing history gathered through said information gathering means and said identification information held by said identification information holding means; and

determining a charging amount per distribution mechanism based on said counted distribution condition and a charging rule for said contents,

wherein the contents utilizing history is stored permanently as long as the contents is utilized,” as recited in claim 1. (Emphasis added)

Applicants refer to page 23, lines 15-20 in the specification for description of an exemplary embodiment of the claimed invention,

“For example, in the case that the contents is a game program, the ***middleware has a function of embedding a message call (function and parameter) in the member card KC by recalling a library provided from the service manager.*** Such examples of the function are shown in Fig. 7. An example of the function is shown at (a), and an example of the parameter is shown at (b).” (Emphasis added)

The cited portions of Stefik et al., and the usage rights described therein, can reasonably be read to include, at most, a message call (function and parameter), and therefore, fail to disclose the claimed digital information itself providing functionality to a user terminal, an exemplary embodiment of which is the above-described middleware having a function of embedding the message call in a member card KC.

Accordingly, Applicants respectfully submit that claim 1 is patentable over Stefik et al. for at least the foregoing reasons. Claims 6 and 9 incorporate features that correspond to those of claim 1 described above, and are, therefore, patentable over Stefik et al. for at least the same reasons.

The Examiner cited Aras et al. as a combining reference to specifically address the respective additional features recited in claims 2-5, 7-8, and 11. And claims 2, 4, 7, and 11 incorporate features that correspond to those of claim 1 cited above. As such, the addition of this reference would still have failed to cure the above-described deficiencies of Stefik et al., even assuming, arguendo, that such an addition would have been obvious to one skilled in the art at the time the claimed invention was made. Accordingly, Applicants respectfully submit that claims 2, 4, 7, and 11, together with claims 3, 5, and 8 dependent therefrom, respectively, are patentable over the cited references for at least the above-stated reasons.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully

requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

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